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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER RUSSELL, CHRISTINA MARIE	
			ART UNIT 2837	PAPER NUMBER

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,101

Applicant(s)

NAGAO ET AL.

Examiner

Christina Russell

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:
2. Figure 7 is mentioned in relation to Figure 1 and then discussed in detail in the specifications. However, reference numbers 24 and 33 were made mention of in reference to Figure 7 but appear in Figure 1 and not Figure 7.
3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

5. In Figure 5, Step S25 is shown but not discussed in the specifications.

6. In Figure 6, element 14 is shown from the memory unit 6 to the dedicated unit 3 but not discussed in the specifications.

7. In Figure 7, element 17 is shown from the MUX 7 to the output unit 4, but not discussed in the specifications.

8. In Figure 9, step S36 is shown in the flow chart but not discussed in the specifications.

9. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

10. The disclosure is objected to because of the following informalities:
11. At the start of the first paragraph, of the section titled Brief Summary of the Invention, the first sentence is unclear in regards to the portion of the sentence that begins after the comma and reads "there is a provided a portable device..."
12. On page 15, in the second paragraph which starts "As shown in Fig. 6, ...", reference number 60 is repeated and the memory unit should be referenced by number 6, not 60, as previously referenced by.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
14. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
15. Claim 16 recites the limitation "the incoming call" at the end of the claim. There is insufficient antecedent basis for this limitation in the claim, since no previous mention of an incoming call was made.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1, 2, 6-10, and 13-20 are rejected under 35 U.S.C. 102(b) as being anticipated by the US patent application publication to Yoshimura (US 2003/0012361).

18. In terms of claim 1, Yoshimura teaches a portable device, or portable phone, with a memory to store digital data, to output units or speaker devices, that output two types of data. The first being the reproduction signal or music to simply listen to or use for karaoke on the device, or music to place someone on hold to, and the second being the incidental, or incoming call melody data. Yoshimura also teaches of a central control unit, or CPU, and a dedicated unit, which consists of a sound source, a sequencer and a playback section (see paragraphs [0001], [0003], [0005], [0022], [0027], end of [0028], [0030], [0034], [0035], [0040], and beginning of [0041]).

19. As for claim 2, Yoshimura teaches all the above claimed elements, including the digital data stored being music data and the first output receiving acoustic or analog data, generated from the dedicated unit, as the reproduction or listening music signal (see paragraphs [0001], [0037] and [0118]).

20. As for claim 6, Yoshimura teaches all the above claimed elements of claim 1, including the dedicated unit being comprised of table information in regards to the incidental or music ring tone data (see the end of paragraph [0025] and paragraph [0047]).

21. As for claim 7, Yoshimura teaches all the above claimed elements of claim 1, including the central control unit or CPU, reading out data from the memory and sending it to the dedicated unit (see paragraphs [0053] and [0082]).

22. As for claim 8, Yoshimura teaches all the above claimed elements of claim 1, including the dedicated unit reading the data from the memory in accordance with the CPU or control unit (see paragraphs [0077], [0078] and [0082]).

23. In terms of claim 9, Yoshimura again teaches a portable device with a memory two output units with two separate data signals, a central control unit and a dedicated unit (see paragraphs [0001], [0003], [0005], [0022], [0027], end of [0028], [0030], [0034], [0035], [0040], and beginning of [0041]). Yoshimura also teaches of a selector that makes it possible to select one of the incidental data signals, or musical tunes for a ring tone, and supply that to the output when an incoming call appears (see Figure 11, paragraphs [0017], [0027], [0028], [0032], [0035], [0040], beginning of [0041], and [0055]).

24. As for claim 10, Yoshimura teaches all the above claimed elements, including the selector unit selecting and data signal from the dedicated unit in accordance with the control unit and the signals it downloads and reproducing in the device (see Figure 11, paragraphs [0017] and [0027]).

25. As for claim 13, Yoshimura teaches all the above claimed elements of claim 9, including said dedicated unit comprising table information that regards the incidental or musical tone data, and further supplies it to the selector so a particular incidental signal can be chosen as a ring tone (see Figure 11, paragraphs [0017], end of [0025], [0027], [0028], [0032], [0035], [0040], beginning of [0041], [0047], and [0055]).

26. As for claim 14, Yoshimura teaches all the above claimed elements of claim 9, including the control unit reading the data from memory, supplying that data to the dedicated unit and the selector unit to be chosen from a menu (see Figure 11, paragraphs [0017], [0027], [0053] and [0082]).

27. As for claim 15, Yoshimura teaches all the above claimed elements of claim 9, including the control unit activating the dedicated unit, selecting a signal and having the dedicated unit reading the data out of memory and executing the reproduction process to convert the data from digital to analog and output or playback the musical tone data (see Figure 11, paragraphs [0017], [0027], [0077], [0078] and [0082]).

28. As for claim 16, Yoshimura teaches all the above claimed elements of claim 9, including a radio, FM, communication unit that serves as a connection device for this portable telephone device, the second output being able to output the incidental, or incoming call data, as a vibration, the control unit controlling the notification (melody or vibration) of the incoming signal, and the dedicated unit performing the reproduction of the signal from memory with regards to a comfortable and appropriate volume level (see Figure 11, paragraphs [0001], [0006], [0017], [0023], [0027], end of [0029], [0042], [0055], [0067], [0076] and [0077]).

29. In terms of claim 17, Yoshimura teaches of a reproducing method for use in a portable device, as previously described. This device gain consists of a memory and a dedicated unit, and the method involves the receiving of data, corresponding to musical data, from said memory, causing the dedicated unit to perform a music reproduction process generating an acoustic or analog signal at a appropriate or recognizable volume level (see paragraphs [0001], [0003], [0005], [0022], [0027], end of [0028], [0030], [0034], [0035], [0037], [0040], beginning of [0041], [0042], [0067] and [0118]).

30. As for claim 18, Yoshimura teaches all the above claimed elements of claim 17, including the portable device outputting the signal as a vibration with the reproduction processing. Yoshimura teaches the ability to change the normal musical tone signal to a vibration during the process done by the dedicated unit (see paragraphs [0029] and [0078]).

31. As for claim 19, Yoshimura teaches all the above claimed elements of claim 17, including outputting the incidental data, or musical tone, and outputting a display in synchronism with the dedicated unit process (see paragraph [0029] and paragraphs previously mentioned regarding the display menus and numbers of the incidental data or musical tones).

32. As for claim 20, Yoshimura teaches all the above claimed elements of claim 17, including the portable device having a central control unit, or CPU, an output unit that can provide a vibration output in accordance with the incoming signal, and the ability to select a signal during the reproduction mode and output that signal, all while being controlled in a separate mode (see paragraphs [0029], [0032], [0077], and [0078]).

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claims 3-5 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura in view of the US patent application publication to Fukumoto et al. (US 2002/0149561).

35. In terms of claim 3, Yoshimura teaches all the above claimed elements of claim 1, including the data being music data, the second output providing vibration and the dedicated unit measuring appropriate volume levels (see paragraphs [0001], [0029], [0042], [0062] and [0124]). Yoshimura does not however teach the intensity of the vibration outputted corresponding to the volume level. Fukumoto does however teach of this correlation (see paragraphs [0297]-[0299] and [0302]-[0304]). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate this additional correlation taught by Fukumoto into the portable device of Yoshimura. Fukumoto teaches of a similar device, or PDA, to Yoshimura's portable phone. Both devices contain a display, a key input, a memory, a CPU, or control unit, speakers and a way to receive incoming signals as either tones or vibrations. Yoshimura already teaches of a volume sensitive playback that approximates the appropriate volume for

the environment the phone is currently in, so correlating those measurements to the regulation of the vibration would be an extra benefit added to the adaptable system.

36. In terms of claim 4, Yoshimura teaches all the above claimed elements of claim 1, including the data being music data, the dedicated unit measuring appropriate volume levels, and the ability to display numbers, characters, menus, images, etc. (see paragraphs [0001], [0029], [0042], [0043], [0067], end of [0097], and [0101]). Yoshimura does not however teach the display being correlated to the volume level. Fukumoto teaches the use of a display as an additionally function of the volume measurements and sound source. Again, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate this additional feature of Fukumoto into the similar device of Yoshimura that already comes equipped with such measurement and display characteristics.

37. In terms of claim 5, Yoshimura teaches all the above claimed elements of claim 1, including the data being music data, the ability to perform a display output obtained from display data, and the ability to measure the frequency wave component of the data (see paragraphs [0001], [0027], [0029], [0097], and [0101]). Yoshimura does not however teach the display of such frequency component. Fukumoto does teach the ability of the claimed invention to display frequency in the form of the amount of resonance or vibration the display unit experiences through the second output of the incoming signal (see paragraphs [0164], [0227], and [0343]). Again, it would have been obvious to one of ordinary skill in the art, at the time of the invention to incorporate this

extra feature taught by Fukumoto into the similar device of Yoshimura, which already consists of the display, frequency, and output features required.

38. In terms of claim 11, Yoshimura teaches all the above claimed elements of claim 9, including the data being musical, the first output comprising acoustic, or analog, data for listening pleasure, the second output being able to provide a vibration in accordance with an incoming signal, a dedicated unit providing said acoustic signal, volume measurement and a selector to select which incidental, or music tone, data to be outputted (see Figure 11, paragraphs [0001], [0017], [0027], [0029], [0037], [0042], [0062], [0118] and [0124]). Yoshimura does not however teach the intensity of the vibration produced corresponding to the measured volume level. Similar to claim 3, Fukumoto again teaches this correlation (see paragraphs [0297]-[0299] and [0302]-[0304]). Once again, it would have been obvious to one of ordinary skill in the art, at the time of the invention to combine these two similar devices with similar capabilities (see rejection argument from claim 3).

39. As for claim 12, Yoshimura teaches all the above claimed elements from claim 1 and 11, including the portable device comprising a radio, FM, communication unit, the control of this unit by the central control unit, or CPU, and the selection of signals by the selector unit (see Fig 11, [0017], [0023], mid [0025], [0027], and [0047]). Yoshimura does not however, teach the intensity of the vibration produced in the second output corresponding to the measured volume level of claim 11. As stated above, Fukumoto does teach this feature and it would again have been obvious to integrate this feature into the similar device of Yoshimura.

Conclusion

40. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The US patent to Tagawa et al. (6,947,728) and the US patent application publications to Swartz et al. (US 2002/0034168) and Toyomura et al. (US 2002/0116575).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Russell whose telephone number is 571-272-4350. The examiner can normally be reached on Mon-Fri, 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on 571-272-2107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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09/29/2005